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three-month extension of time, a response to the March 10, 2003 Office Action is now due September 10, 2003. Accordingly, this Communication is being timely filed.

#### REMARKS

Claims 208, 210, 213, 214, 221-225, 228, 230, 231, 233-239 and 250 are pending in the subject application and under examination. Of these claims, claims 233 and 234 have been indicated as allowable. The remaining claims stand rejected.

#### Rejection under 35 U.S.C. §102(e)

On page 3 of the March 10, 2003 Office Action the Examiner rejected claims 208, 210, 213, 214, 221-225, 228, 230, 231, 235-239 and 250 as being anticipated by Barnes, et al., U.S. Patent No. 6,518,399, which claims priority of a U.S. provisional application filed October 9, 1998 and a British patent application filed September 7, 1998. The Examiner alleged that Barnes, et al. discloses assays for agonists of a GABA<sub>B</sub>R1/R2 receptor, wherein the GABA<sub>B</sub>R1 polypeptide is either the rat GABA<sub>B</sub>R1a or GABA<sub>B</sub>R1b polypeptide, each of which is 100% identical to the instant SEQ ID NO: 56 and 55, respectively, and wherein the GABA<sub>B</sub>R2 polypeptide is the human GABA<sub>B</sub>R2 that is 100% identical to the instant SEQ ID NO: 47. The Examiner also alleged that assays are disclosed wherein the activity is measured via changes in cAMP, GTP S incorporation, or GIRK1

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and GIRK4-evoked changes in current. The Examiner further alleged that the use of human GABA<sub>B</sub>R2 polypeptide in such assays is fully supported in prior U.S. Provisional Application No. 60/103,670, filed October 9, 1998.

In response, applicants respectfully traverse the rejection under 35 U.S.C. §102(e) and maintain that the pending claims are patentable over Barnes, et al. ('399).

Applicants initially note that solely for purposes of this response and not as a concession of the underlying facts applicants will assume that the Barnes, et al. '399 patent is entitled to a September 7, 1998 effective filing date.

As evidenced by the attached Declaration of Kenneth A. Jones, Thomas M. Laz and Beth Borowsky, under 37 C.F.R §1.131 ("the Declaration"), applicants conceived the claimed invention and actually reduced to practice in the United States an embodiment of the claimed invention prior to September 7, 1998. Specifically, independent claims 208, 213 and 224 recite a process for determining whether a chemical is an agonist of a mammalian GABA<sub>B</sub>R1/R2 receptor which comprises contacting cells containing nucleic acid encoding, and expressing on their cell surface, the GABA<sub>B</sub>R1/R2 receptor, wherein such cells prior to being transfected with such nucleic acid do not express the GABA<sub>B</sub>R1/R2 receptor, with the compound under conditions permitting the activation of the GABA<sub>B</sub>R1/R2 receptor, and detecting an increase in activity of the

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GABA<sub>B</sub>R1/R2 receptor, wherein said increase in activity indicates that the compound is an agonist of a GABA<sub>B</sub>R1/R2 receptor, wherein the mammalian GABA<sub>B</sub>R1/R2 receptor comprises a GABA<sub>B</sub>R1 polypeptide and a GABA<sub>B</sub>R2 polypeptide.

The accompanying Declaration Under 37 C.F.R. §1.131 specifically shows that prior to September 7, 1998, such an assay was performed in the United States by Meng Dai, under the direction and supervision of Kenneth A. Jones, a coinventor, at the laboratories of Synaptic Pharmaceutical Corporation, the assignee of record of the subject application. The notebook page of Meng Dai shows that such an assay determined that the chemical compound aminobutyric acid (GABA) agonist, binds to and activates such a mammalian GABA<sub>B</sub>R1/R2 receptor, i.e. a rat GABA<sub>B</sub>R1/R2 receptor. This experiment clearly demonstrates that the coexpression of a mammalian GABA<sub>B</sub>R1 receptor and a mammalian GABA<sub>B</sub>R2 receptor by transfected cells was useful to determine whether a chemical compound was an agonist of a mammalian GABA<sub>B</sub>R1/R2 receptor.

Applicants maintain that in view of the accompanying Declaration under 37 C.F.R. §1.131, Barnes, et al. should be withdrawn as a reference. Furthermore, applicants respectfully request that the rejection based on Barnes, et al. therefore be reconsidered and withdrawn.

In summary, in view of the remarks made hereinabove, applicants respectfully request that the Examiner reconsider

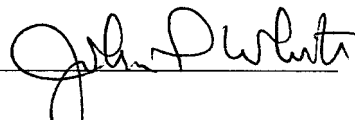
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and withdraw the rejection set forth in the March 10, 2003 Office Action and allow all pending claims, namely claims 208, 210, 213, 214, 221-225, 228, 230, 231, 233-239, and 250.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

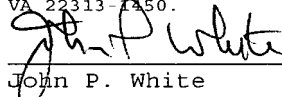
No fee, other than the enclosed fee of \$920.00, is deemed necessary in connection with the filing of this Communication. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White  
Registration No. 28,678  
Attorney for Applicants  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, New York 10036  
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

 9/10/03  
John P. White Date  
Reg. No. 28,678